

### **REMARKS**

Claims 1-23 are all the claims pending in the application. By this Amendment, Applicant amends claims 1-3, 5-7, 11, 14-18, 20, 22, and 23. Claims 1, 2, 7, and 23 have been amended to further clarify the invention. Claims 3, 5, 6, 11, 14-18, 20, and 22 are editorially amended to fix minor informalities. The amendments to claims 3, 5, 6, 11, 14-18, 20, and 22 were made for reasons of precision of language and consistency, and do not narrow the literal scope of the claims and thus do not implicate an estoppel in the application of the doctrine of equivalents. The amendments to claims 3, 5, 6, 11, 14-18, 20, and 22 were not made for reasons of patentability.

In addition, by this Amendment, Applicant adds claims 24-28. Claims 24-28 are clearly supported throughout the specification.

### **Summary of the Office Action**

The Examiner has entered all of the amendments to the claims. In addition, the Examiner withdrew his previous rejections of claims 1, 3, 5, 11, and 17 under 35 U.S.C. § 112, second paragraph, claims 1 and 19 under 35 U.S.C. § 102(b) and claims 3, 4, 13-18, and 22 under 35 U.S.C. § 103(a). The Examiner, however, retained some of the previous rejections and issued new rejections.

#### ***A. Repeated Rejections***

Claims 7-10, and 21 still stand rejected under 35 U.S.C. § 102(b) as being anticipated by USP 4,376,816 to Hayashi et al. (hereinafter "Hayashi"). Moreover, claims 2 and 20 are still rejected under 35 U.S.C. § 103(a) as being unpatentable over USP 6,130,023 to Coppens et al.

(hereinafter “Coppens”) in view of Hayashi. Furthermore, claim 11 still stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Hayashi in view of USP 6,306,254 to Usui (hereinafter “Usui 1”) and JP abstract 03036545 to Goto et al. (hereinafter “Goto”), whereas claim 12 still stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Hayashi in view of JP 8-39958 to Usui et al. (hereinafter “Usui 2”) and further in view of USP 5,729,962 to Dirx (hereinafter “Dirx”). Finally, claim 5 still stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Coppens in view of Hayashi, Usui 1 and Goto, whereas claim 6 still stands rejected under 35 U.S.C. 103(a) as being unpatentable over Coppens in view of Hayashi and Usui 2.

***B. New Rejections***

The Examiner also issued new rejections. Specifically, claims 19 and 21 are objected to for failing to further limit the invention. Claims 1, 3, 5, 7-12, 17 and 19-23 stand rejected under 35 U.S.C. § 112, first paragraph. Claims 1 and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Coppens in view of Hayashi, claim 3 as being unpatentable over Coppens in view of Hayashi and further in view of Usui 1 and Goto. Claim 4 stands rejected as being unpatentable over Coppens in view of Hayashi, Dirx and Usui 2. Claims 13-16, 18 and 22 stands rejected as being unpatentable over Coppens in view of Hayashi and Usui 1, claim 17 as being unpatentable over Coppens in view of Hayashi and Usui 1. Claim 23 stands rejected under 35 U.S.C. § 102(b) as being anticipated by a newly found reference, USP 3,767,451 to Busch (hereinafter “Busch”).

**Claim Rejections**

Applicant respectfully traverses these numerous rejections and respectfully requests the Examiner to reconsider these rejections in view of the comments, which follow. First, Applicant traverses the rejections of the independent claims 1, 2, 7, and 13, then, the rejections of the dependent claims 3-6, 8-12, and 14-22, and concludes with the rejections of the independent claim 23.

***A. Independent Claims 1, 2, 7, and 13***

Independent claims 1 and 7 are rejected under 35 U.S.C. § 112, first paragraph. In addition, claims 1 and 2 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Coppens in view of Hayashi and claim 7 is rejected under 35 U.S.C. § 102(b) as being anticipated by Hayashi. Claim 13 stands rejected as being obvious in view of Hayashi, Coppens and Usui 1.

With respect to the rejection under 35 U.S.C. § 112, first paragraph, claims 1 and 7 have been amended and no longer include the subject matter allegedly not adequately described in the specification. Therefore, it is appropriate and necessary for the Examiner to withdraw this rejection with respect to these independent claims 1 and 7.

In addition, independent claims 1, 2 and 7, as now amended, recite: “wherein the density of the material is 0.7 to 0.85 grams per cubic centimeter.” The Examiner acknowledges that Hayashi and Coppens fail to teach or suggest this feature of the claims (see page 11 of the Office Action). The Examiner, however, alleges that Usui 1 cures the deficient teachings of the two references. Applicant respectfully disagrees. Applicant respectfully submits that Hayashi fails

to teach or suggest a planographic printing plate and that there is no motivation to combine the references in the manner suggested by the Examiner.

*Hayashi does not teach or suggest a planographic printing plate*

In response to arguments submitted in the Amendment under 37 C.F.R. § 1.111 filed on January 23, 2004, the Examiner alleges that the lithographic printing plate of Coppens, photothermographic printing plates of Hayashi, photosensitive printing plate of Usui 1 and a planographic printing plate as set forth in the independent claims are all equivalent to each other (see pages 15-16 of the Office Action). To support this position, the Examiner cites definitions from a Merriam Webster Dictionary. The Examiner combines the different properties of the packaging material for these various printing materials to somehow meet the claim language.

Applicant respectfully submits that this position is technically inaccurate. Perhaps this point can best be illustrated by an analogy, therefore, the following example is presented. Consider three writing instruments: a pencil, a piece of chalk and an oil paint. All three writing instruments may be used to form an image, as can thermography and planography. A pencil, however, is used for writing on a piece of paper, a chalk is used for writing on a blackboard and an oil paint is used for writing on a canvas. A piece of paper, a blackboard and a canvas each may be planar but the characteristics of a blackboard certainly are not the same as those of an improved piece of paper.

Similarly, different considerations are addressed when packaging and storing the blackboard and the piece of paper. For example, the piece of paper may become yellow with time. To prevent this from happening, the piece of paper may be put under a glass, whereas such

issues do not arise in storing the blackboard. Similarly, the considerations for Hayashi's packaging material for storing photothermographic material are not the same as those for a novel packaging material for a planographic printing plate.

For example, Hayashi teaches a packaging material for the photothermographic sheet material (or dry-type organic silver film). In other words, the object being stored is not a printing plate but a dry-type organic silver film. Although the feature of smoothness is considered in terms of placing a smooth sheet between the films, an index to evaluate storage performance is sensitivity. Hayashi does not address the density of the material or the relative humidity because these characteristics are not essential for storing the photothermographic film.

On the other hand, the planographic printing plates are especially vulnerable to moisture and density. In other words, just like different considerations are important in packaging a piece of paper versus a blackboard, different considerations are important in the packaging material of the photothermographic film versus planographic plates, and these different considerations arise from the different characteristics or structures of the different types of materials being stored. For example, since Hayashi does not teach or suggest a printing plate, Hayashi clearly does not address the characteristics of separating the protection sheet from the surface of the printing plate. This is not a consideration for storing a photothermographic sheet. Similarly, Hayashi does not teach or suggest that damages may appear on the image forming surface, for example, because of peeling.

In short, Hayashi teaches a method for storing sheets of photothermographic film material using a smooth sheet intervening between the films. An index to evaluate the storage

capability of such sheets is sensitivity. In Hayashi, the object to be stored is not the printing plates as set forth in the independent claims but a photothermographic sheet material. Moreover, Hayashi does not address considerations such as separability of the protection sheet from the surface of the printing plate and possible damages of the image forming surface. Therefore, Hayashi does not teach or suggest a packaging material for the planographic printing plates as set forth in the independent claims 1, 2, 7, and 13.

*Coppens does not teach or suggest the packaging material  
as set forth in the independent claims 1, 2, 7, and 13*

Coppens, on the other hand, teaches a method of producing lithographic printing plates (according to a silver salt diffusion transfer process). Properties such as base weight, pH, weight of formaldehyde are described in connection with the package materials used. These materials, however, are not technically indispensable elements of the method in Coppens. Coppens regards a packaging sheet as a means to only maintain the condition and performance of the printing plate itself. Coppens, however, fails to consider the separability of a protection sheet from a plate and that the plate is protected from being damaged while the plate is being used. The range of consideration is thus clearly different. As a result, Coppens does not address the characteristics of the protection sheet (*e.g.*, Bekk smoothness values) as recited in the independent claims 1, 2, 7, and 13.

*There is no motivation to combine Hayashi, Coppens and Usui I*

Moreover, there is no motivation to combine the references in the manner suggested by the Examiner. First, Applicant respectfully submits that one of ordinary skill in the art would not have used Hayashi's interleaving sheets to store Coppens lithographic plate, for which different

considerations for its storage must be addressed. For example, the density and the relative humidity are not the characteristics to consider when packaging photothermographic sheet, as such they are clearly not addressed in Hayashi. In short, one of ordinary skill in the art would not have been motivated to use the packaging material for storing film to store the printing plates. The Examiner's combination can be compared to the example above of using the glass for the storage of paper to store a blackboard. There is no motivation to combine Hayashi and Coppens.

Moreover, the Examiner acknowledges that neither Hayashi, nor Coppens taken alone or in any conceivable combination teach or suggest "the density of the material is .07 to .85 grams per cubic centimeter." The Examiner, therefore, cites Usui 1 to cure this deficiency in Hayashi and Coppens, alleging that one of ordinary skill in the art would have been motivated to combine the density characteristic as taught by Usui 1 to stabilize the sensitivity of the printing plates as quickly as possible because it is always desirable to stabilize the printing plates as quickly as possible (see page 17 of the Office Action). Applicant, first, respectfully points out that density of a printing plate is not linked to the stabilization of the sensitivity of the photosensitive printing plate material. Therefore, one of ordinary skill in the art would not have been motivated to use the density as taught by Usui to stabilize the sensitivity of the printing plates.

In addition, Usui 1, as acknowledged by the Examiner, deals with a problem of preferable air permeability for stabilizing sensitivity of a plate quickly. This reference has nothing to do with protecting photothermographic sheets for a prolonged storage as taught by Hayashi (col. 1, lines 34 to 42). One of ordinary skill in the art, confronted with a problem of prolonged storage,

for example for a period of about two years, would never have turned to a reference which stabilizes sensitivity of the printing plates quickly.

In short, one of ordinary skill in the art would not have combined the references in the manner suggested by the Examiner. Therefore, claims 1, 2, 7, and 13 are believed to be patentable over the combined teachings of Hayashi, Coppens, and Usui 1.

***B. Dependent Claims 3-6, 8-12, and 14-22***

The Examiner rejected the dependent claims under 35 U.S.C. § 103(a), in view of Hayashi, Coppens, Usui 1 and other prior art references, Goto, Usui 2 and Dirx. The exemplary deficiencies of Hayashi, Coppens and Usui 1, as set forth above, are not cured by Goto, Usui 2 and Dirx, either alone or in any combination. Consequently, claims 3-6, 8-12, and 14-22 are patentable over the applied references, at least by virtue of their dependency.

In addition, the Examiner rejected dependent claims 3, 5, 11, and 17 under 35 U.S.C. § 112, first paragraph. The Examiner alleges that the term “relative humidity” is not supported in the specification (see page 5 of the Office Action). With respect to these dependent claims, however, the Examiner acknowledges that “relative humidity” and “moisture” are equivalents and therefore, the Examiner repeated the prior art rejection for these claims (see page 3 of the Office Action). The MPEP does not require the wording of the claims to be identical to the terminology in the specification. Rather, the test is whether the specification reasonably conveys to one of ordinary skill in the art the claimed invention. One of ordinary skill in the art would readily recognize that the two terms are synonyms, as admitted by the Examiner. Therefore, this rejection of claims 3, 5, 11, and 17 should be withdrawn.



**C.     *Claims 23-25***

The Examiner alleges that claim 23 and the limitations of claims 24-25 disclose new matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor was in possession of the invention (see page 4 of the Office Action). Namely, the Examiner is contending that a packaging sheet with different Bekk smoothness values on various sides is a new matter (see pages 2-3 of the Office Action).

This feature, however, is supported by the originally filed specification at page 16-17, Table 1 and page 18-20, Table 2, for example. That is, the specification discloses a packaging material with a contacting portion having a Bekk smoothness value between 3 and 11 seconds (see paragraph abridging pages 16 and 17). The specification also discloses one illustrative, non-limiting embodiment of setting the non-contacting surface of the packaging material to a predetermined Bekk smoothness value (see page 18, second paragraph).

Moreover, the specification discloses that the planographic printing plate packaging material of the present invention is not limited to the interleaf described above. That is, ones, which contact and protect the imaging surface of the planographic printing plate 10 and whose non-contacting portions which contact the non-imaging surface will satisfy the above described requirements, i.e. a Beck smoothness from 3-55 seconds (page 18, second paragraph and page 19, first full paragraph). The contacting portion of the packaging material may have a Bekk smoothness values between 3-900 seconds (page 19, second full paragraph). The specification also discloses that in determining the Bekk smoothness value of the contacting surface, deterioration of the image surface (peeling) must be taken into a consideration. On the other

hand, when determining a Bekk smoothness value of the non-contacting surface, only the separability of the packaging material from the printing plate is important. In other words, the specification discloses a Bekk smoothness value for a surface and not for the entire packaging material. Therefore, one of ordinary skill in the art would understand that it is within the scope of the invention to have a packaging material with two different surfaces (i.e., image contacting and image non-contacting, wherein the surfaces have different Bekk smoothness values). Therefore, this rejection of claims 23-25 under 35 U.S.C. § 112, first paragraph should be withdrawn.

Claim 23 is also rejected under 35 U.S.C. § 102(b) as being anticipated by a newly found reference, Busch. To be an “anticipation” rejection under 35 U.S.C. § 102, the reference must teach every element and recitation of the Applicant’s claims. Rejections under 35 U.S.C. § 102 are proper only when the claimed subject matter is identically disclosed or described in the prior art. Thus, the reference must clearly and unequivocally disclose every element and recitation of the claimed invention.

Claim 23, as now amended, recites “at least one planographic printing plate” and a packaging material with two opposing surfaces, “a first surface contacts the imaging surface of the printing plate when packaged with the printing plate, and an opposing surface having a different Bekk smoothness from that of the first surface.” The Examiner alleges that Busch teaches a packaging material having surfaces with different smoothness.

Busch, however, teaches a method of manufacturing a manifolding paper coated with pressure ruptured materials. This type of paper has nothing to do with a packaging material or a

planographic plate. In addition, Busch simply teaches a method of manufacture and it fails to teach or suggest a packaging material contacting the imaging portion of a printing plate. In other words, Busch fails to teach or suggest a number of limitations of claim 23. Therefore, the Examiner is respectfully requested to reconsider and withdraw this rejection of claim 23.

Moreover, Busch does not cure the deficient teachings of Hayashi, Coppens and Usui 1. Therefore, dependent claims 24-25 are patentable at least by virtue of their dependency on claims 1 and 7.

#### **New Claims**

In order to provide more varied protection, Applicant adds claims 24-28.

#### **Conclusion**

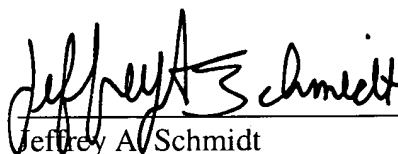
In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly invited to contact the undersigned attorney at the telephone number listed below.

Amendment Under 37 C.F.R. § 1.111  
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Respectfully submitted,

A handwritten signature in black ink, appearing to read "Jeffrey A. Schmidt", is written over a horizontal line.

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